



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Stephenson et al.

Attorney Docket No. 054998/0002

Serial No.: 10/039,296

Examiner: Not assigned

Filed: October 19, 2001

Group Art Unit: Not assigned

For: NON-VOLATILE MAGNETIC MEMORY DEVICE

CERTIFICATE OF EXPRESS MAILING

Commissioner for Patents
Washington, D.C. 20231
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I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 CFR 1.10 on the date indicated below and is addressed to: Commissioner for Patents, Box Missing Parts, Washington, D.C. 20231.

Sir:

Express Mail Label No. EV032055867US
Date of Deposit: September 13, 2002

Signature: 

Gerard Bilotto, Reg. No. 51,474
Kramer Levin Naftalis & Frankel LLP

**STATEMENT OF MANOJ PUNDIT, ESQ., EXECUTIVE VICE PRESIDENT AND
GENERAL COUNSEL OF MICROMEM TECHNOLOGIES, INC.**

1. My name is Manoj Pundit and I am the Executive Vice President and General Counsel of Micromem Technologies Inc., 777 Bay Street, Suite 1910, Toronto, Ontario M5G 2E4. I make this statement in support of a Petition to Proceed Without Inventor Participation under 37 C.F.R. 1.47(a) to prosecute the above-referenced application without the participation of inventors James C. Stephenson and Daniel Carothers who have refused or failed to execute a Declaration in the prosecution of the above-referenced application.

2. This Statement provides proof of the relevant facts alleged in the Petition submitted in connection with the above-identified application in accordance with 37 C.F.R. 1.47(a).

3. On May 17, 2002, I sent via registered mail with the Canadian Postal Service and by courier through Fedex a Declaration and Power of Attorney and Assignment, prepared by the Attorneys of Kramer Levin Naftalis & Frankel LLP, to Mr. James C. Stephenson and Mr. Daniel Carothers, formerly employees of Memtech International Inc., a wholly-owned subsidiary of

Micromem Technologies Inc., to review and sign. A copy of the registered mail receipts from the Canadian Postal Service and Fedex waybills, as proof of receipt of the Declaration and Assignment by Mr. Stephenson and Mr. Carothers, are attached herewith as Exhibits 1 and 2 respectively. As shown in Exhibits 1 and 2, Mr. Stephenson's packages were addressed to 1368 Linda Rosa Avenue, Salt Lake City, Utah 84106, his last known address, and Mr. Carothers' package was addressed to BAE Systems Merrimack Facilities, MER 15 – 1813, 130 Daniel Webster Hwy., Merrimack, NH 03054, being the address of his then current employer, to which he advised us by telephone to forward the said Declaration.

4. On May 27, 2002, I wrote to Mr. Stephenson, by e-mail (a copy of which is attached as Exhibit 3), asking whether or not he was going to sign the Declaration and Assignment documents that were sent to him. On June 4, 2002, I wrote to Mr. Stephenson again, by e-mail, (a copy of which is attached as Exhibit 4), requesting him to forthwith execute the Declaration and Assignment and return them to me, as required under his employment agreement with Memtech International Inc., and that failure to do so would constitute a breach of his employment agreement. On June 5, 2002, Mr. Eric Lee, Mr. Stephenson's attorney, wrote to us on Mr. Stephenson's behalf to advise that Mr. Stephenson was refusing to execute the Declaration or Assignment. A copy of Mr. Lee's letter is attached hereto as Exhibit 5. To date, we have not heard from Mr. Stephenson or his attorney and we do not have an executed Declaration or Assignment from Mr. Stephenson.

5. The priority application for the above-identified application was filed when Mr. Stephenson was an employee of Memtech International Inc. Under the terms of Mr. Stephenson's Employment Agreement, he has an obligation to assign any invention and sign all necessary documents related to any such invention, including a Declaration and Assignment. The cover page, signature page and pertinent clauses of Mr. Stephenson's Employment Agreement regarding his obligation to sign documents and to cooperate with Memtech International Inc. regarding patent applications filed as an employee are attached as Exhibit 6.

6. On May 29, 2002, Mr. Carothers wrote to me, by e-mail, (copy attached as Exhibit 7) indicating that his current employer's legal department was reviewing the documentation and that he would sign it thereafter. To date, Mr. Carothers has failed to sign and deliver the Declaration or Assignment to us. On June 4, 2002, I wrote to Mr. Carothers, by e-mail, (attached as Exhibit 7),

requesting him to forthwith execute the Declaration and Assignment and return them to me, as required under his employment agreement with Memtech International Inc., and that failure to do so would constitute a breach of his employment agreement. Notwithstanding Mr. Carothers' indication from his May 29, 2002 (Exhibit 7) e-mail to sign the Declaration and Assignment documents to date we have not received an executed Declaration or Assignment.

7. The priority application for the above-identified application was filed when Mr. Carothers was an employee of Memtech International Inc. Under the terms of Mr. Carothers' Employment Agreement, he has an obligation to assign any invention and sign all necessary documents related to any such invention, including a Declaration and Assignment. The cover page, signature page and pertinent clauses of Mr. Carothers' Employment Agreement regarding his obligation to sign documents and to cooperate with Memtech International Inc., regarding patent applications filed as an employee are attached as Exhibit 8.

8. Based on the foregoing facts and circumstances, Mr. Stephenson has failed to sign the Declaration and Assignment for the above-identified application despite his contractual obligation to do so under the terms of his Employment Agreement. In order to protect Mr. Stephenson's interests the patent application was filed on his behalf.

9. Based on the foregoing facts and circumstances Mr. Carothers has failed to sign the Declaration and Assignment for the above-identified application despite his contractual obligation to do so under the terms of his Employment Agreement. In order to protect Mr. Carothers' interests the patent application was filed on his behalf.

10. As a consequence of Mr. Stephenson's and Mr. Carothers' failure to cooperate as set forth above, Micromem Technologies Inc.'s attorneys from Kramer Levin Naftalis & Frankel LLP have prepared the accompanying Petition supported by this statement requesting permission under 37 C.F.R. 1.47 to proceed without Mr. Stephenson's and Mr. Carothers' signatures in the prosecution of the aforementioned application.

Dated: Sept. 12, 2002

Respectfully submitted,

By: 

Manoj Pundit, Esq.
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Kramer Levin Naftalis & Frankel LLP

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**PETITION TO PROCEED WITHOUT
INVENTOR PARTICIPATION UNDER 37 CFR § 1.47(a)**

Applicant herewith submits this Petition under 37 CFR § 1.47(a) for a ruling that the above-referenced application may be properly made without the signatures of non-signing joint inventors James C. Stephenson and Daniel Carothers.

This Petition is being submitted concurrently with a Declaration and Power of Attorney (with the signature block for the non-signing inventors left blank) executed by Mr. Bruce Shipely for himself and all of the non-signing joint inventors. The accompanying Declaration and Power of Attorney set forth the last know address of the non-signing inventor, Mr. Stephenson. The last known address for Mr. Carothers is as set forth in the accompanying statement of Mr. Pundit and attached Exhibits.

To date, Mr. Stephenson and Mr. Carothers have refused to sign the Declaration and Power of Attorney and Assignment for the above-referenced application despite their contractual obligation to do so under the terms of their Employment Agreement with Mircomem Technologies, Inc. Mr. Stephenson's attorney has specifically stated that Mr. Stephenson will not be executing the Declaration or Assignment. Mr. Carothers has acknowledged receiving the

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Declaration and Power of Attorney and Assignment documents but has failed to return the executed documents despite repeated attempts to obtain his cooperation.

The specific facts and documentary proofs setting forth Mr. Stephenson's and Mr. Carothers' refusal and failure to execute the Declaration and Power of Attorney and Assignment are set forth in the accompanying Statement of Mr. Manoj Pundit, Executive Vice President and General Counsel of Micromem Technologies, Inc., the assignee of the present application. Enclosed with Mr. Pundit's Statement are eight (8) Exhibits documenting Mr. Stephenson's and Mr. Carothers' refusal and failure to cooperate and setting forth the diligent efforts which were made to obtain the signatures of the non-signing inventors.

Applicants submit that the accompanying Statement of Mr. Pundit and the attached Exhibits establish that the non-signing inventors, Mr. Stephenson and Mr. Carothers, refuse to participate in the prosecution of the above-referenced application, and that Applicant should be permitted to prosecute the application to protect the interests of all of the joint inventors. Favorable consideration of this Petition is earnestly solicited.

The Commissioner is hereby authorized to charge Deposit Account No. **50-0540** in the amount of \$130.00 for payment of the required fee under 37 CFR 1.17(h). In addition, the Commissioner is authorized to charge any such fee(s) or credit any overpayment(s) as deemed necessary for the entry of this Petition to Deposit Account No. **50-0540**. A duplicate copy of this Petition is provided herewith.

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Respectfully submitted,

KRAMER LEVIN NAFTALIS & FRANKEL LLP
Attorneys for Applicants

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